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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,094	08/20/2003	Tomohiro Shinoda	3022-0019	4947
70432	7590	08/14/2007		
ALFRED A. STADNICKI 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209			EXAMINER HARPER, TRAMAR YONG	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/644,094	Applicant(s) SHINODA, TOMOHIRO	
	Examiner Tramar Harper	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7-12, 14 and 25-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-12, 14, & 25-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment filed 5/29/07. The arguments set forth in the response are addressed herein below. Claims 2-5, 7-12, 14, & 25-43 remain pending and Claims 1, 6, 13, & 15-24 have been canceled.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-5, 7-12, 14, and 25-43 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 7,001,276. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the pending instant application are broader in scope with respect to claims 1-19 of US patent 7,001,276. In

regards to the independent claims 8, 25, and 35 of the instant application, Applicant discloses a gaming machine that comprises a figure and a token with a built-in integrated circuit chip (including storage means) attachable/detachable to the base portion of the figure. The token contains game initialization data relative to the character for use with the gaming machine. The gaming machine reads the game initial data when the figure with the token is set on the gaming machine. Claims 1-19 of US patent 7,001,276 disclose the above and further includes an upward-facing recess for attaching the figure and the token for reading the gaming data. Although this feature is not explicitly disclosed in detail in the instant application, Claims 2-5, 7-12, 14, and 25-43 still require a reading means on the gaming machine for reading the game initial data, and therefore is encompassed in the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 5, 7-10, 12, 14, 25-28, 30-31, 33-37, 39-40, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al (US 6,877,096).

Claims 2-3, 5, 7-10, 12, 14, 25-28, 33-37 & 42-43: Chung discloses a gaming environment wherein a token is introduced to an input device connected to a gaming console enable a range of functionality into a game (Abstract). Chung discloses that the design of the input device 100, 105 (wherein the token is introduced and are three

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dimensional) may take the form of the nature of the game and be a control device. For example, for a racing car game the device may take the form of the player's racing car (character or figure) and the tokens may represent different parts of the car, such as engine, wheels, etc (such qualities are known as character data or bonus data, which is interpreted as data gaining a player further incentives of capabilities). The more tokens the greater the capabilities (Col. 6:30-42). Chung also discloses that each disc may correspond to a different weapon. The more discs that have been introduced, the more weapons a player has access to (interpreted as a bonus incentive/profit). Chung further discloses that each disc may correspond to a different database providing such game initial/conditional data (Col. 5:1-8). As such, this is interpreted as discs/tokens containing game initial data from a plurality of game initial/conditional data. Also in terms of the base portion in which one or more tokens are attachable/detachable from, Chung discloses the devices 100, 105 (which represent two token readable devices (Col. 2:36-37)) contain a top portion 107 and a bottom base portion 110. The one or more tokens may be attached on the upper surface of the base body portion of devices 100, 105 (Col. 2:43-44, 43-54). Chung discloses a 3d integrated circuit disk/token comprising of a RFID a microprocessor (figure 3 processor), a control gate array, storage or memory, and a connector (Col. 3:55-64, Col. 5:48-60, Figs. 1-3). The token includes a stored character data set (Col. 5:1-14). 4:50-60 discloses a stored interactive game.

Chung fails to disclose reading the game initial data of the respective figure when the figure with the token is set on the gaming machine. However, Applicant has not

disclosed that reading the game initial data when the figure with the token is set on the gaming machine provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Chung's figure with token linked to the gaming machine, and applicant's invention, to perform equally well with either the data read when the figure with token linked to the gaming machine, as taught by Chung, or the claimed data read when the figure with token is set on the gaming machine because both would perform the same functions of reading the gaming initial data to the gaming machine.

Therefore, it would have been prima facie obvious to modify Chung such that the game initial data is read when the figure with token is set on the gaming machine because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chung.

Claims 30 & 39: Chung discloses the above limitations with respect to Claims 25 & 35, but excludes the game initial data comprising of an identification code for identifying the token. Chung discloses that the reading device is capable of acquiring identifying indicia stored on or within discs. Chung discloses the use of frequency id's, bar codes, etc. for identifying the various tokens (Col. 3:55-Col. 4:44). However, Applicant has not disclosed providing an identification code within the game data provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Chung's identification means (see above), and applicant's invention, to perform equally well with either the identifying the token via radio frequency id, bar codes, etc, as taught by Chung, or the claimed game initial data including an

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identification code because both would perform the same functions of identifying a token.

Therefore, it would have been prima facie obvious to modify Chung such that the game initial data includes an identification code because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chung.

Claims 31 & 40: Chung discloses that the more tokens the greater the capabilities (Col. 6:30-42). Chung also discloses that each disc may correspond to a different weapon. The more discs that have been introduced, the more weapons a player has access to (interpreted as a bonus incentive/profit). Chung further discloses that each disc may correspond to a different database providing such game initial/conditional data (Col. 5:1-8). Chung discloses that disc can correspond to some bonus data such a missile launcher that initially contains a predetermined amount of missiles (Col. 6:1-15)(e.g. a data set with a predetermined profit).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al (US Patent 6,877,096) as applied to the claims above in view of Nakamura (US Patent 6,468,162).

Chung discloses all of the instant application as discussed above but lacks in disclosing selecting initial data sets randomly from a initial data group. Nakamura teaches a character information data set selected from a plurality of items of a character information data group at random and stored on a portable media device for use in an arcade or domestic gaming machine (Col. 6:13-18). Nakamura discloses that the data

can be selected and stored based on information not already stored on the portable media device (Col. 2:31-33, interpreted as bonus data or information). It would have been obvious to one of ordinary skill at the time of the invention to modify the token gaming system, as taught by Chung, with to randomly select character/bonus gaming information, as taught by Nakamura, to provide player enjoyment of purchasing and collecting character/bonus information and enhance a player's hope of getting character information which the player has not possessed (Col. 2:6-20).

Allowable Subject Matter

Claims 5, 11, 29, 31- 32, 38, and 40-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 5/29/07 have been fully considered but they are not persuasive. In regards to the previous double-patenting rejection, the rejection has been clarified to overcome the arguments regarding the upward-facing recess. Applicant stated that WO 98/51384 was incorrectly cited in the IDS and Examiner has recited the document for purposes of having the prior art on record.

Independent Claims 8, 25, and 35

Applicant states that the advantage to over come the token of Chung is that a player can recognize the game initial data read when the form or figure with the token is set on the gaming machine is for a particular game character from the appearance of the attached form or figure. Examiner submits that the Applicant misunderstands the

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rejection and the limitation of placing the figure with the token on the gaming machine is what the design choice rejection is solely based upon. Applicant fails to point of within in the specification a reasonable advantage of placing the figure with the token on the gaming machine.

Furthermore, Chung discloses that the design of the input device 100, 105 (wherein the token is introduced and are three dimensional) may take the form of the nature of the game and be a control device. For example, for a racing car game the device may take the form of the player's racing car (character or figure) and the tokens may represent different parts of the car, such as engine, wheels, etc. Examiner interprets "game initial data is selectable from the identified character's initial data" to read upon the above, considering that the figure represents the character or car used in the game and the tokens represents the game initial data to be used or selectable with the identified character's initial data. As such, the car that the player uses in the game receives the attributes attached the figure of that car used by the player. Also, considering that there are more than one input devices that can be in the form of figures indicates that there are more than one type of character or car within the game.

Claims 4 and 11

Applicant's remarks regarding these claims lacks any spurious arguments and is therefore disregarded.

Claims 39 and 40

Applicant fails to point to the specification any advantage to the game initial data also includes an identification code identifying the token. Chung discloses that the reading

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device is capable of acquiring identifying indicia stored on or within discs. Furthermore, Chung discloses the use of frequency id's, bar codes, etc. for identifying the various tokens (Col. 3:55-Col. 4:44). Examiner interprets this as providing the same functionality as claimed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mawie et al (US 6,773,325) discloses a figure with memory card attachable/detachable to various gaming systems.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Ronald Laneau
Primary Patent Examiner
Art Unit 3714

TH

8/3/07